

REMARKS

Claims 1, 2, 4-12 and 14-39 are presented for examination. Claims 1, 4, 6, 8, 10, 12, 14, 16, 18-21, 34, 36 and 38 are independent claims. Claims 11, 28, 37 and 39 have been amended to correct the informalities kindly noted by the Examiner in paragraph 2 of the Office Action. No change in the scope of any claim element has been made. Favorable reconsideration is respectfully requested.

Claims 1, 4-10, 12, 14 and 16-39 were rejected under 35 U.S.C. § 103(a) as being obvious from U.S. Patent Application Publication 2001/0041056 (Tanaka et al.) in view of Japanese Laid-Open Patent Application 06-233044 (Tanaka et al.), and Claims 2, 11 and 15 were rejected under Section 103(a) as being obvious from those two documents in view of U.S. Patent 6,313,877 (Anderson).

After a careful study of the Office Action and the prior art, Applicant finds himself unable to agree that these rejections are proper, for at least the following reasons.

Independent Claim 1 is directed to a method for displaying on an image display device an image stored in an image storage device. The method of Claim 1 comprises a determination step of determining whether an image is to be displayed or characters related to the image are to be displayed, in accordance with the number of images stored in the image storage device.

Tanaka '056 relates to transmission and reception of image information, such as images captured by a digital camera. The *Tanaka '056* system can provide a user remotely with a list of available files (paragraph [0087]), to permit the user to select a file for display. As the Examiner correctly notes at page 3 of the Office Action, however, nothing in *Tanaka* teaches or suggests making a choice between (1) displaying characters

relating to an image file and (2) displaying the image itself, based on the volume of images that are stored, as recited in Claim 1. That claim, therefore, is allowable over *Tanaka '056* taken alone (Applicant understands that the Examiner agrees with this conclusion).

To supply what is missing from *Tanaka '056* as a reference against Claim 1, the Examiner relies on *Tanaka '044*. For the following reasons, however, Applicant strongly believes that the modification of *Tanaka '056* required to meet the terms of Claim 1 (addition of the determining means) is not suggested in any way by *Tanaka '044*.

In *Tanaka '044*, a facsimile machine determines whether or not to print a received transmission in its entirety, based on the number of sheets in the transmission. If that number is over a set threshold, then instead of printing the transmission, a “monitor report” is generated and printed out. That report may contain reduced images of one or more pages of the transmission. The Office Action interprets this portion of *Tanaka '044* as teaching that if the received transmission includes images, then the report could include the names of the images “when this teaching is applied to the transfer of images between an image storage device and an image receiving device as taught by Tanaka (US) [*Tanaka '056*].” .

Applicant cannot agree that *Tanaka '044* contains any such teaching, either explicitly or in any other way. First, the translation of record does not refer to a transmission containing images, and thus certainly does not suggest anything about the specific handling of such a transmission. Presumably, reduced images of the sheets of the transmission could be in the monitor report, but nothing in that translation even hints at generating characters (either image names or anything else) to be shown in the report in lieu of images in the actual transmission.

Moreover, there is no hint as to how such characters could be generated.

For these reasons, Applicant submits that the outstanding rejection is in fact based on mere speculation about what *could* be done using the facsimile machine in *Tanaka '044*, and goes far beyond what a person of ordinary skill would understand in that document, or be enabled to do by that document.

Accordingly, Applicant believes strongly that the Office Action fails to set out a valid rejection of Claim 1, and believes that claim to be clearly allowable over *Tanaka '056* and *Tanaka '044*, taken separately or in any permissible combination (if any).

Claims 10 and 14 are article and program claims, respectively, corresponding to method Claim 1, and are believed to be allowable over *Tanaka '056* and *Tanaka '044* for at least the reasons discussed above with regard to Claim 1.

Independent Claim 4 is directed to a method for displaying on an image display device, an image stored in an image storage device. The method of Claim 4 comprises a determination step of determining whether an image is to be displayed or the name of an image is to be displayed, in accordance with the number of images stored in the image storage device.

Claims 12 and 16 are article and program claims, respectively, corresponding to method Claim 4.

Claims 4, 12 and 16 are believed to be allowable over *Tanaka '056* and *Tanaka '044* for at least the same reasons discussed above with regard to Claim 1.

Independent Claim 6 is directed to a method for transmitting image data from an image storage device to an image reception device. The method of Claim 6 comprises a determination step of determining whether image data is to be transmitted or

identification of the image data is to be transmitted by the image storage device to the image display device, in accordance with the number of images stored in the image storage device.

Nothing in *Tanaka '056* and *Tanaka '044* is believed to teach or suggest making a determination as to whether an image is to be transmitted or a text that includes the name of the image or the like is to be transmitted, in accordance with the number of images, as recited in Claim 6, and that claim is believed to be clearly allowable over those documents, taken separately or in any permissible combination (if any) for at least that reason.

Claims 18 and 21 are article and program claims, respectively, corresponding to method Claim 6, and are believed to be allowable over *Tanaka '056* and *Tanaka '044* for at least the reasons discussed above with regard to Claim 6.

Independent Claim 8 is directed to a method for transmitting image data from an image storage device to an image reception device. The method of Claim 8 comprises a determination step of determining whether image data is to be transmitted or an image name is to be transmitted to the image reception device by the image storage device, in accordance with the number of images stored in the image storage device.

As discussed above, nothing has been found or pointed out in *Tanaka '056* and *Tanaka '044* that is seen to teach or suggest making a determination as to whether (1) the image data is to be transmitted or instead (2) the name of image is transmitted, in accordance with the number of images. For at least this reason, Claim 8, and corresponding device and program Claims 19 and 20, are believed to be clearly allowable over those documents.

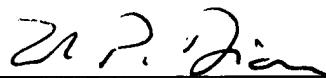
A review of the other art of record has failed to reveal anything which, in Applicant's opinion, would remedy the deficiencies of the art discussed above, as references against the independent claims herein. Those claims are therefore believed patentable over the art of record.

The other claims in this application are each dependent from one or another of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicant respectfully request favorable reconsideration and allowance of the present application.

Applicant's undersigned attorney may be reached in our New York Office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,



Leonard P. Diana
Attorney for Applicant
Registration No. 29,296

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3801
Facsimile: (212) 218-2200

NY_MAIN 546741v1